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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/909,042

07/19/2001

Kenichiro Matsuura

B588-021

8469

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06/23/2006

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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/909,042 | MATSUURA ET AL. | |
| | Examiner | Art Unit | |
| | Prieto Beatriz | 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 105-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 105-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/01/06 has been entered. Claims 1-104 have been canceled, claims 105-116 have been added and remain pending.

2. Acknowledgment is made to claim priority under 35 USC §119 for the benefit of the earlier filing date with respect to Japanese Patent Application No. 2000-222814 filed July 24, 2000. A certified copy of the application has been received and placed in file.

3. Claims terminology has been applied the broadest reasonable interpretation in light of the specification (see MPEP 2111/2106). In this case, the claimed terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term unless the applicant provides an explicit definition for a term, in which case that definition will control interpretation of the term as it is used in the claim. Specifically, the claimed term(s)/clause(s): (i) "abstract" has been interpreted as information that has been summarized or condense form; (ii) "not presentable" at the target terminal has been interpreted as information not being able to be shown, viewed or rendered; (iii) "the forwarding terminal" broadly, speaking is a storage device (e.g. a server) associated with respective conversion module, the server accessible by the target terminal, i.e. recipient (p. 12, line 25 to p. 13, line 25, and p. 16, line 6-27).

Claims 105-116 claimed terms reciting a "reception unit", "generation unit", "first sending unit", "second sending unit", and "determination unit" seem to lack explicit antecedent basis in view of the specification, the broadest reasonable interpretation in light of the specification will be applied to these claimed terms.

Claim clause "search for a generation device appropriate for the document file based on an extension of the document file", particularly the claimed term "generation device" seems to lack antecedent basis in the specification. However, the disclosure does seem to describe

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performing a search, specifically, a search for an appropriate conversion module for converting this image into a JPEG image (step S333). If an appropriate conversion module is found, whether price in the conversion module table 706f is set to 0 (zero) is determined (step S334) [see par 0124]. The broadest reasonable interpretation in light of the disclosure will be applied (see MPEP 2111/2106), in this case, seek, look for, examine, inquire for, i.e. “search” for a module “generation device” for the document file based on the format, i.e. file extension.

Claim Rejection under 35 U.S.C. 103

4. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

5. **Claim 105 is rejected under 35 USC 103(a) as being unpatentable over Fields, D.K., et. al. (EP 1 058 199 A2) referred to as Fields hereafter**

Regarding claim 105, Fields discloses a computer implemented method [0024, 0036], the method comprising:

determine whether a document file is attached to electronic mail data by parsing [0011 and/or 0025 or scanning 0013] the electronic mail data received by said reception unit [0012, server 0016, and/or checking for receipt 0025];

a generation unit [0016] adapted to, when said determination unit determines that a document file is attached, removing or stripping the document file attachment and generating text string data representing an “abstract” of a document indicated by the document file [0011, 0013], wherein abstract comprising a compressed version of the attached document file [0026];

a first sending unit [0016] adapted to send the document file attached to the electronic mail data received by said reception unit to a first storage “Web server” [0011] first storage including an accessible store or a web server [0023], although Fields does not explicitly utilized claimed nomenclature, specifically with respect to the term “abstract”, although a specific deliberate definition has been made in the disclosure, the claimed term has been interpreted light of the specification of the invention and applied the broadest reasonable interpretation. In this

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case, abstract has been interpreted as summarized or condensed form, this does not exclude the compressed version disclosed by the reference thus has been treated as a functional equivalent. One would be motivated to applied the teachings of Fields because in doing so the communication terminal may selectively obtain the file attached to the electronic mail data, as suggested by Fields.

6. Claims 106-107, 110-112, 115-116 are rejected under 35 USC 103(a) a being unpatentable over Fields as applied on claim 105 in view of Kucmerowski (US 2001/0013871).

Regarding claim 106, Fields teaches where the communication terminal (10a-10n) includes a personal computer, notebook, Internet appliance, or computing device [Fields: 0021] or any computer or component connectable to the Internet [Fields: 0038] however Fields does not explicitly teach where the communication terminal comprises a portable telephone.

Kucmerowski teaches where the communication terminal includes a wireless/cordless i.e. ‘portable’ telephone [see par 0012];

a reception unit (6) adapted to receive “electronic mail” data [0012 on p. 2];

determining the number of characters of the received data for displaying the received data and determining the number of characters displayable on the display associated with the communication terminal [0012 on p. 2] and

determining that the character string to be displayed is equal to, less or greater than the characters displayable on a display [0015-0016 & 0022].

It would have been obvious at the time the invention was made to one of ordinary skilled in the art to combine the teachings of Schaffer generating second information from transmission information when determined that the recipient display is not capable of displaying transmission information with the teachings of Kucmerowski for distributing information to a plurality of displays in accordance to the display capabilities would be readily apparent. One would further be motivated to utilize the teachings of Kucmerowski for transmitting information in accordance with the capabilities of the receiving display, specifically displaying information having a predetermined length on a display having different capabilities, such as the when the total

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characters of a message exceeds the amount of characters displayable on a particular display. One would be motivate to combine these teachings because in doing so it enables devices, e.g. having a smaller size/length that the message to be transmitted to be displayed.

Regarding claim 107, said second sending unit is operable to send information indicating that the document file attached to the electronic mail data have been sent to the web server by said first sending unit [Fields: 0033]

7. Claims 108 & 113 are rejected under 35 USC 103(a) a being unpatentable over Fields in view of Kucmerowski in further view of SHAFFER et. al. (US 6,092,114) (Shaffer hereafter)

Regarding claim 108, however the above-mentioned prior art does not explicitly disclose searching for a module appropriate for the document file based on an extension of the document file.

Shaffer teaches reception means (12) for receiving “electronic mail” data (col 3/lines 63-col 4/line 4, step 40 of Fig. 2, col 6/lines 6-18 and col 8/lines 35-41);

determine the file format of an document file attached to the received electronic mail data based on the file extension of the document file (column 2, lines 43-65);

lookup for a module based on the file extension of the document file and determining if the module is available on the intended electronic mail data recipient’s communication terminal (column 2, lines 43-65); and converting the document file to be presentable at the communication terminal using the identified module based on the attachment file extension (step 52 of Fig. 2, col 6/line 66-col 7/line 6).

It would have been obvious at the time the invention was made given the suggestion Fields for determine whether a document file is attached to electronic mail data and modifying the electronic mail data in a form presentable to a wireless/portable intended recipient to include the teachings of Schaffer. Because in doing so the electronic mail data could further be modified based on the file extension, as suggested by Schaffer, enabling modification of the document file at the server or recipient’s device.

8. Claims 109 & 114 are rejected under 35 USC 103(a) as being unpatentable over Fields in view of Kucmerowski in further view of Batchelder et. al. (US 5,691,708) (Batchelder hereafter)

Regarding claim 109, a second determination unit adapted to determine whether the number of characters of mail text of the electronic mail data exceeds the number of displayable characters of the communication terminal [Kucmerowski: [0015-0016 & 0022]; however the above mentioned prior art does not explicitly teach determining that the number of characters of the mail text exceeds the number of displayable characters.

Batchelder teaches 10, a unit (50) adapted to determine whether the number of characters of a text message exceeds the number of displayable characters of the recipient's communication terminal; where when the number of characters of the message text exceeds the number of displayable characters, generate abstract of the message text, and sending the abstract of the message text generated to the communication terminal (column 1, lines 10-63 and column 2, line 58-column 3, line 13); wherein the text message comprises electronic mail (column 3, lines 14-30, 60-67) and the abstract comprises abstracted text (column 3, lines 2-4) or abstraction of the electronic mail message (column 3, lines 60-67).

It would have been obvious to one of ordinary skill in the art at the time the invention given the suggestion of Fields for processing electronic mail message to a format suitable for the intended recipient communication terminal to include the teachings of Batchelder for abstracting text message for enabling these messages to be displayed without leaving off the end of the message, omitting critical information or not displaying the message at all as in the prior art, discussed by Batchelder.

Regarding claim 110, "information providing method", comprising each of the steps for each of the units in claim 105, namely, the reception, determination, generation first sending, and second sending units as described on claim 105, each adapted to perform respective functions claimed thereon, thus same rationale for the respective, reception step associated with the reception unit, the determination step associated with the determination unit, the generation step associated with

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the generation unit, the first sending step associated with the first sending unit and the second step associated with the second sending unit, same rationale of rejection is applicable.

Regarding claims 111-113, these claims are substantially the same as claims 106-108, same rationale of rejection is applicable.

Regarding claim 114, this claim is substantially the same as claim 109, same rationale of rejection is applicable.

Regarding claims 115-116, a computer program stored on a computer readable medium that when executed on a computer causing a computer to execute the information providing method of claim 110 (Fields: 0024, 0036).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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B. Prieto
Primary Examiner
TC 2100
June 21, 2006


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